

Docket No.: 52292-023



PATENT

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Michael Paul WOLF, et al.

Serial No.: 09/731,048

Filed: December 07, 2000

For: CONTROL, SOUND, AND OPERATING SYSTEM FOR MODEL TRAINS

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Group Art Unit: 3617

Examiner: Mark T. Le

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**RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
Washington, DC 20231

Sir:

In response to the Restriction requirement dated October 11, 2001, having a one-month shortened statutory period for response set to expire on November 13, 2001, Applicants' hereby elect Group I drawn to a model train system (claims 1-3, 30, 31, 44-61, 70-75, 90 and 91) with traverse. It is noted that the Examiner has inadvertently left out claims 30 and 31 from the model train system of Group I. It is respectfully submitted that the Examiner's groupings are incorrect for the following reasons.

In general, it is respectfully submitted that the claims of Groups III, VI and VIII are NOT subcombinations as relied on by the Examiner, but rather, are combination claims that define various features of the same combination of a model train system (e.g., sound control, remote control, and/or accessories). Accordingly, the claims of Groups III, VI, and VIII are not subcombinations of the claims of Group I, nor are they subcombinations usable together. Instead, they are the same combination of a model train system with emphasis on different features and functionalities of the combination.

For example, if the model train system of the present invention is generically defined as a combination of different features selected from any two or more elements ABC...Z, then a subcombination claim would separately define details of any one of the specific elements A...Z of the combination (e.g., "Z comprising the elements Z', Z"...). In the instant case, however, each of the claims in the alleged subcombinations of Groups III, VI, and VIII define AB, AC, BC, ... etc.. That is, they do NOT define just A', B', Z", ... etc.. Accordingly, the claims of Groups III, VI, and VIII are NOT subcombinations. Put in another way, the claims of Groups III, VI, and VIII do not separately define the "sub-parts" of the combination of Group 1 as required to be a subcombination; rather, they define the same combination of Group I, but with different features/functionalities selected from elements A ... Z (e.g., sound control, accessories, remote control) that comprise the generic combination of the model train control system of the present invention.

**A. Group I and Group III are NOT related as combination and subcombination**

It is respectfully submitted that the Examiner's reference to Group III as a "subcombination" of Group I is incorrect. Instead, Group I and Group III are both **combination** claims of a model train system, where each define different features as part of the same combination. For example, both claim 1 of Group I and claim 6 of Group III define a combination "track interface unit" and "train track layout". The only difference is the input source for the "track interface unit", where claim 1 utilizes a "remote control unit" and claim 6 utilizes an "external sound source". Defining different features in claims 1 and 6 does not amount to a combination-subcombination relationship between the two claims; instead, claims 1 and 6 merely define the same combination of a model train system of the present invention in

two different ways. The relationship between claims 1 and 6 is similar to having a single independent claim which defines a "track interface unit" and a "track layout", with two dependent claims defining the respective sources (i.e., sounds and remote control) for the "track interface unit". It is submitted that Applicants have the right to set forth in a single application a plurality of independent claims that define a combination (in the instant case, a model train system), with each independent claim emphasizing a *different feature/functionality* (e.g., sounds, remote control, etc.) of the *same combination*. Similar reasoning applies to the other claims of Group III (e.g., model train with Doppler effect in claim 41, as an added element /functionality to the generic combination of a model train system).

As the name implies, a combination is a claim that recites a plurality of distinct elements to form a combined structure, where each of the distinct, individual "elements" can represent a subcombination of the combination. A subcombination claim, in turn, is any one of those elements defined separately. Returning to the previous example, claim 6 is NOT a sub-combination of claim 1 for at least the reason that it includes elements that make up the combination of claim 1 (e.g., "train track layout", "track interface unit"). A true subcombination of claim 1 would be an independent claim that defines the specific features of the "remote control unit", "track interface unit" or "train track layout" of claim 1. The following is an example of a proper subcombination of claim 1:

100. A remote control unit for use with a model track layout, comprising:
  - a housing;
  - a plurality of buttons for inputting information; and
  - a memory for storing the information.

Claim 100 above is an example of a claim that would be considered a subcombination of claim 1 because it further defines the element "remote control unit" of the combination of elements recited in claim 1, whereby (1) claim 1 does not depend on the details of the remote

control unit set forth in claim 100 for patentability, and (2) the remote control unit of claim 100 can be used in a device other than a model train system.

However, claim 6 does not further define any element of claim 1; but rather, claim 6 defines the same combination of elements ("track interface unit" and "track layout") with a different feature (e.g., sound) being emphasized in the same combination (as discussed above, similar to reciting a single independent claim having two dependent claims). This point is further evidenced by the fact that claim 1 *does* rely on the particulars of claim 6 for patentability (i.e., "track interface unit" and "train track layout"). It follows that claim 6 does NOT have separate utility than claim 1 because claim 6 must also be used in a model train system that includes a "train track layout" and "track interface unit" as used in claim 1. Whereas, sample claim 100 has separate utility in that it can be used in any electronic device (not necessarily a train track with a track interface unit), and claim 1 does not depend on the particulars of the remote control (e.g., "plurality of buttons") recited in sample claim 100 for patentability.

Based on all the foregoing, it is respectfully submitted that Group I and Group III are not related as combination/subcombination as set forth by the Examiner, and therefore, claims 6-17, 41-43 and 62-67 of Group III should be included in the elected claims of Group I.

**B. Group I and Group VI are NOT related as combination and subcombination**

For reasons similar to those discussed above with respect to Group III, it is submitted that claims 26, 27 and 32-35 of Group VI are NOT subcombinations of the combination claims of Group I. For example, claim 26 also defines the same combination elements of a "track interface unit" and a "train track layout". Again, claim 26 simply adds/emphasizes different features/functionalities (e.g., accessory interface unit) of the same combination with respect to

the claims of Group I. Similar reasoning applies to the other claims of Group VI (e.g., claim 32 adds a model train to the generic combination of the present invention). It follows that Group III and Group VI are not related as subcombinations usable together in a single combination as also alleged by the Examiner because Groups III and VI themselves represent a version of the "single combination."

Based on all the foregoing, it is respectfully submitted that Group I and Group VI are not related as combination/subcombination as set forth by the Examiner, nor are Groups III and VI related as subcombinations useable together. It is therefore respectfully submitted that claims 26, 27 and 32-35 of Group VI should be included in the elected claims of Group I.

**C. Group I and Group VIII are NOT related as combination and subcombination**

For reasons similar to those discussed above with respect to Groups III and VI, it is submitted that claims 36-40 of Group VIII are NOT subcombinations of the combination claims of Group I. For example, claim 36 does NOT define the details of any *individual* (i.e., subcombination) feature of a claim in Group I as a separate independent claim (similar to sample claim 100 above). Again, claim 36 simply identifies different features/functionalities (e.g., a track interface unit that includes a memory for storing sounds) of the same combination of a model train system that is set forth in Group I. Similar reasoning applies to the other claims of Group VIII. It follows that Group III, Group VI, and Group VIII are not related as subcombinations usable together in a single combination as also alleged by the Examiner because Groups III, VI, and VIII themselves represent a version of the "single combination."

Based on all the foregoing, it is respectfully submitted that Group I and Group VIII are not related as combination/subcombination as set forth by the Examiner, nor are Groups III, VI,